

to Claims 20, 31, 37, 40, and 43 to clarify and better define the claimed invention. No new matter is added by this Amendment.

The Examiner has rejected:

(a) Claims 20-25, 33, 35, and 38-46 under 35 U.S.C. § 103 as being unpatentable over Orii (U.S. patent 5,200,863) (hereinafter "Orii") in view of Sasaki et al. (U.S. patent 5,034,804) (hereinafter "Sasaki") and in further view of Takahashi (U.S. Patent 5,067,029) (hereinafter "Takahashi");

(b) Claims 34 and 36 under 35 U.S.C. § 103 as being unpatentable over Orii in view of Sasaki and in further view of Finelli (U.S. Patent 4,937,676) (hereinafter "Finelli");

(c) Claims 31 and 37 under 35 U.S.C. § 103 as being unpatentable over Lang (U.S. Patent 4,963,995) (hereinafter "Lang") in view of Sasaki; and

(d) Claim 32 under 35 U.S.C. § 103 as being unpatentable over Lang in view of Sasaki and in further view of Watanabe (U.S. Patent 5,032,927).

Applicants respectfully traverse each of the above rejections.

In regard to Claims 20 and 43, the present invention is directed to a camera which provides, generally, the ability to selectively transfer image information from an imaging device to a first memory or a second memory for storage, where such selection is determined in accordance with a condition of one of the two memories.

In particular regard to Claim 20, the Examiner combines the Orii reference with the teachings of both

Sasaki and Takahashi to render the claimed inventions obvious. Orii is directed to an image data recording system consisting of a camera (10) and an electrically coupled video tape recorder (25). Camera (10) receives a semiconductor memory card (24), and video tape recorder (25) receives a magnetic storage medium (26a). Unlike Applicants' claimed inventions, the Orii reference teaches that any information stored in magnetic storage medium (26a) is derived from semiconductor member (24). Specifically, from column 4, lines 39-44, Orii provides:

The above-described video tape recorder 25, when connected to the output terminal 19, magnetically records the image signals derived from the memory card 24 of the camera apparatus 10 on a magnetic cassette tape 26 for permanent or long term or short term storage of the image signals corresponding to the images.  
(emphasis added) (see also column 13, lines 9-12).

The Examiner cites elements (33) and (108) of Orii as being in accord with the claimed changer. Consistent with the Applicants' summary of Orii set forth above, the Examiner provides that elements (33) and (108) cooperate for,

...copying [an] image from the first memory to the second memory....

In accordance with the Examiner's own findings, Orii fails to disclose, teach, or suggest a changer which would enable the selection of one memory or another memory to receive image information output from an imaging device.

For combination with Orii, the Sasaki reference discloses camera (10) which stores image information on

card memory (15). The Examiner cites Sasaki as teaching a camera using a semiconductor memory.

Applicants respectfully submit that if Sasaki is given its broadest interpretation for combination with the Orie reference, the deficiencies of Orie are not overcome. While Orie includes no teaching, motivation, or suggestion of replacing the magnetic medium (26a) of Orie with a semiconductor memory (for example, as used in Sasaki), the combination of these references does not provide the resulting system with a changer which would enable the selection of one memory or another memory to receive image information output from an imaging device.

For combination with Orie and Sasaki, the Examiner also cites Takahashi as teaching a camera apparatus having a plurality of differing memories which are provided in a camera housing. The memory types include optical recording unit (30), semiconductor memory (40), magnetic recording unit (50). The differing memories of Takahashi are provided for different operational scenarios. Consequently, the provision of a camera with only like memory types (e.g., semiconductor and semiconductor, optical disc and optical disc, etc.) is counter to the express and implicit teachings of Takahashi. To this end, Takahashi fails to include any disclosure, teaching, or suggestion of a camera or image generating system which incorporates a plurality of semiconductor memories for image data storage.

Additionally, the Takahashi reference does teach of a selector (24) to select between memories (30), (40), and (50). Takahashi is silent with regard to the

selector (24) being positioned based on a detected condition of one of a first semiconductor memory or a second semiconductor memory.

In addition to these references failing to disclose, teach, or suggest the claimed invention, neither Orii, Sasaki, nor Takahashi include the requisite motivation or suggestion required for the combination for these references. From the MPEP,

A statement that modifications of the prior art to meet the claimed invention would have been "well within the ordinary skill of the art at the time the claimed invention was made" because the referenced relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references.

MPEP 2143.01 (7th ed., 1998) (citing *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993) (first emphasis in original) (second emphasis added)).

To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.

MPEP 2142 (7th ed., 1998) (citing *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985); see *Ex parte Skinner*, 2 USPQ2d 1788 (Bd. Pat. App. & Inter. 1986)).

In consideration of the above discussion and the Examiner's obligation in construing the cited references for purposes of combination, Orii, alone or in combination with Sasaki and/or Takahashi, does not disclose, teach, or suggest the claimed invention. Applicants respectfully submit there exists no evidence

that one having ordinary skill in the art could reasonably combine these references to derive the present invention nor render it obvious.

The above discussion is equally applied to Claim 43 as well as the claims which properly depend from Claims 20 and 43.

In regard to Claims 23, 38, and 40, the present invention is directed, at least in part, to a camera which provides, generally, the ability to selectively transfer image information from a first memory or a second memory to a reproduction device for purposes of reproducing image information stored on the aforementioned memories.

In regard to Claim 23, the Examiner rejected the claimed invention over the references discussed above. The claimed invention requires, in part,

a changer for selectively changing between a first condition, in which image information on the first memory is outputted to the first reproduction device, and a second condition, in which image information on the second memory is outputted to the first reproduction device.

In particular regard to Orit, the Examiner expressly found that the reference failed to disclose, teach, or suggest the claimed changer ("Orit . . . fails to specifically teach that the reproduced image information from the first semiconductor and second semiconductor memory is supplied to a reproducing device." Office Action, page 4. See also, Office Action, page 3). Applicants submit Sasaki and Takahashi fail to disclose, teach, or suggest that which would overcome the deficiencies of Orit.

Sasaki teaches of display (107), which is coupled to and receives image information from memory card (15) alone. The Takahashi reference does not substantively speak of a reproduction device and is silent to the concept of a reproduction device which selectively supports two storage media. Notwithstanding the disclosures and teachings of these references, the Examiner took Official Notice that it would have been obvious to one of ordinary skill in the art to modify the proposed combination of references to enable image information to be transmitted to monitor (27) from either memory (24) or magnetic medium (26a). Applicants traverse the Examiner's Official Notice.

The Office Action provides,

. . . it would have been obvious to one of ordinary skill in the art to modify the proposed combination apparatus of Orii, Takahashi and Sasaki by supplying the image information from the first semiconductor memory and second semiconductor memory [of Sasaki] to the monitor (27) in order to provide more convenience to the user in selecting the image information in either first or semiconductor memory [sic] for viewing. . . . .

(Office Action, page 4) (emphasis added).

In accordance with the requirements of MPEP 2144.03, Applicants respectfully request the Examiner to supply, as soon as practicable, sufficient evidence to support the basis for the Official Notice. Applicants submit that none of the cited references provide that which is suggested in the excerpt set forth above. Applicants further submit that finding a combination is simply more "convenient" is not sufficient, without more, to justify the combination of these references.

Orii, alone or in combination with Sasaki and/or Takahashi, does not disclose, teach, or suggest the claimed invention. Further, Applicants respectfully submit one having ordinary skill in the art could not reasonably combine these references to derive the present invention nor render it obvious.

The above discussion is equally applied to the more specifically claimed invention of amended Claim 38 and the appropriate portions of amended Claim 40 as well as the respective depending claims of Claims 23, 38, and 40.

In regard to Claims 34 and 36, the Examiner combines the teachings of Orii and Sasaki with Finelli. In addition to the teachings of Orii and Sasaki set forth above, Finelli is cited as teaching a camera having a printing device.

While an integral printing device is included within the Finelli camera, Applicants respectfully submit that Finelli fails to contribute that which would overcome any one of the deficiencies produced by the combination of Orii and Sasaki. Specifically, Finelli is silent with regard to a changer for selectively changing between a first or a second memory destination for image data supplied from an imaging device (Claim 20) or a changer for selectively directing the output from a first or a second memory device to a reproduction device (Claim 23).

Orii, alone or in combination with Sasaki and/or Finelli, does not disclose, teach, or suggest the claimed invention of either Claim 34 or Claim 36. Further, Applicants respectfully submit one having ordinary skill

in the art could not reasonably combine these references to derive the present inventions nor render them obvious.

In regard to Claim 31, the present invention is directed to an editing device which provides, generally, a first reception unit, which receives a removable memory card; a second reception unit, which receives a memory device; a signal processor to restore processed image information stored on the memory card to original image information; and a recorder to record the original image information on the memory device. The Examiner rejects the invention of Claim 31 over the Lang reference in combination with Sasaki.

The Lang reference is directed to a device capable of transferring original data from a first removable storage medium (23<sub>1</sub>) to a second removable storage medium (23<sub>2</sub>); however, the reception unit (11) can only receive one storage medium (23<sub>1</sub>) at a time. During a transfer of data, original data is taken from storage medium (23<sub>1</sub>), compressed, and stored in memory (13). Subsequently, the compressed data of memory (13) is expanded and transferred to storage medium (23<sub>1</sub>), which then occupies the space vacated by storage medium (23<sub>1</sub>).

While the Lang reference appears to include a plurality of elements in accordance with the claimed invention, Applicants respectfully submit that the Lang reference fails to disclose an original, removable storage medium (e.g., storage medium (23<sub>1</sub>)) that stores compressed image data. Without such limitation, Lang fails to likewise disclose, teach, or suggest of:



a signal processor to restore processed image information, stored on the memory card, to original image information obtained in a photographing operation.

The Examiner relies upon Sasaki for the generalized teachings of removable memory cards. However, as provided above, even if fixed memory (13) of Lang were interchangeable with a conventional memory card (for example, memory card (15) of Sasaki), neither Lang nor Sasaki provide for a second reception unit or a signal processor in accordance with the claimed invention.

There is some suggestion in the Examiner's findings at pages 6 and 7 of the Office Action that in addition to the "first reception unit" found within Lang, that Sasaki includes a reception unit which could be combined with the cited one or more reception units of Lang to render obvious the present invention. Applicants respectfully submit that the Examiner's dissection and combination of only portions of the Lang and Sasaki references without motivation therefrom, but from the Applicants' claimed inventions alone, is impermissible.

Lang, alone or in combination with Sasaki, does not disclose, teach or suggest the claimed invention. Further, Applicants respectfully submit one having ordinary skill in the art could not reasonably combine these references, whether as cited or with any other known reference, to derive the present invention nor render it obvious.

The above discussion is equally applied to the claims which depend from Claim 31.

In regard to the rejection of Claim 32, Applicants respectfully submit that neither the specific compression algorithm disclosed within Watanabe nor its other teachings contribute that which would overcome the shortcomings of the combined Lang and Sasaki references.

Applicants respectfully submit Claims 20-25 and 31-46 are patentably distinct over the cited references and this application is considered to be in condition for allowance. Applicants respectfully request Examiner's reconsideration of this matter in light of this Amendment and withdrawal of all Section 103 rejections.

This Amendment does not result in an increase in either the number of independent claims or the total number of claims, and does not present any multiple dependency claim. Accordingly, no fee based on the number or type of claims is incurred by this Amendment. However, if a fee were to be required, please charge any fee (other than an issue fee) required during the pendency of this U.S. patent application to Deposit Account 18-1260.

Respectfully submitted,



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